UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/192,735	11/16/98	CONKLIN J	ET98-001

LM02/0128

MAUREEN STRETCH
26 CHARLES STREET
NATICK MA 01760

EXAMINER	
MEINECKE DIAZ,S	
ART UNIT	**PAPER NUMBER**
2765	11

DATE MAILED: 01/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/192,735	Conklin et al.
Examiner	**Group Art Unit**
Susanna Meinecke-Díaz	2765

☒ Responsive to communication(s) filed on *Nov 16, 1998* .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-38* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-38* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *7*

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the citizenship of each inventor (Jeffrey Conklin, in particular).

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 03, 12 (from Figure 1a) and 1A-1L, 60, 64, 74 (from Figure 1g). Correction is required.

Specification

3. The disclosure is objected to because of the following informalities:

Page 70, line 5, delete "10", insert --10-1--

Appropriate correction is required.

Claim Objections

4. Claims 11, 22, and 30 are objected to because of the following informalities:

Claim 11, line 2, delete "cites", insert --sites--

Claim 22, line 2, delete "enables", insert --enable--

Claim 30, line 3, delete "cites", insert --sites--

Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al. (U.S. Patent No. 5,924,082).

[Claims 20 & 21] Silverman et al disclose a method for international transaction processing, comprising the steps of:

negotiating a transaction through a multivariate negotiations engine system (col. 12, lines 48-50) which includes storage space (implied at least in col. 13, lines 11-14), and negotiations software, the multivariate negotiations engine system being connected to an international network (col. 6, lines 52-54);

activating a destination terminal connected to the international network, the destination terminal including software for sending and receiving terms along a communications path over the international network which flows through the multivariate negotiations engine system (Figs. 1, 4A; col. 12, lines 14-17, 47-58);

activating an initiating terminal connected to the international network, the initiating terminal including software for sending and receiving terms along a communications path over the international network which flows through the multivariate negotiations engine system, during transaction processing the multivariate negotiations engine system enabling the initiating terminal and the destination terminal to select each other for a transaction, propose terms for the transaction and negotiate the terms, using the negotiation software (Figs. 1, 4A; col. 12, lines 14-17, 47-58; col. 13, lines 1-24).

Silverman et al teach a well-known technique of negotiating, incorporating a "free-style dialog" for example (Silverman: col. 12, line 51). Since a dialog implies a conversation between at least two parties and certain terms may be renegotiated (Silverman: col. 13, lines 9-11), an artisan of ordinary skill in the art at the time of Applicants' invention would have reasonably interpreted such negotiations to be iteratively performed. Furthermore, Silverman et al discuss an alternative embodiment where only one of the parties may choose the values of certain terms (col. 12, lines 26-30), which is synonymous with the existence of a "deciding entity."

[Claim 22] The step of international processing to enable proposed terms to be selected from and processed in internationally accepted formats is inherent since transactions can be conducted globally (col. 6, lines 52-54).

[Claim 23] The step of enabling the creation of a sponsored community with prescribed rules and procedures for participants is deemed to be inherent to the method of claim 20 (e.g., transaction participants must be chosen); therefore, the rejection of claim 20 applies to claim 23 as well.

[Claim 24] Official notice is taken that remote web authoring software using predefined templates as well as creating and customizing a web site are old and well-known in the art. It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to enable a user to create and customize its own website within Silverman et al's multivariate negotiations engine system through use of remote web authoring software with predefined templates in order to provide merchants with improved means for effective, international advertising.

[Claim 25] Silverman et al state that their invention could be used for a range of markets (col. 13, lines 31-51); therefore, the Examiner asserts that Silverman et al's invention could be modified to sell products more tangible than stocks. Further, official notice is taken that it is old and well-known to order sample quantities of an item before actually placing an order for the item itself. It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to enable Silverman et al's invention to accommodate the ordering of

sample quantities of a physical product (i.e., a product more tangible than stocks) in order to allow a customer to test a product before he/she must commit to buying it. Such a process is very common in the engineering field where electronic components, for example, are often purchased in large quantities. Before making the commitment to purchase an item in bulk, it is important for the customer to test the product to verify its quality and compatibility with the customer's particular needs.

[Claim 26] Silverman et al disclose the step of enabling the recording and retrieving of each set of proposed terms from each terminal to minimize the risk that final terms can be repudiated later (col. 13, lines 11-14).

[Claim 27] Database software is inherent to Silverman et al's invention (e.g., to store and retrieve any sort of data).

[Claims 28 & 29] Official notice is taken that it is old and well-known in the art to conduct commercial as well as non-commercial transactions/negotiations over a network. It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to enable Silverman et al's invention to perform commercial transactions and non-commercial negotiations over a network in order to reach a larger customer base (e.g., both big businesses and individual customers alike).

[Claims 30-32] Official notice is taken that it is old and well-known in the art to physically locate a system at a participant's site, be it at one or more central sites, a sponsor site, or a participant's site on a network. It would have been obvious to one of ordinary skill in the art at

the time of Applicants' invention to verify a participant's location as part of Silverman et al's invention in order to facilitate transaction payment and verification (e.g., to aid in preventing fraud).

[Claims 33-36] Official notice is taken that it is old and well-known in the art to use an open, public network, private network, virtual private network, or local area network internal to an entity. It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to make Silverman et al's invention compatible with as many types of networks as possible to suit the needs of as large of a customer body as possible.

[Claim 37] Official notice is taken that web browsers are old and well-known in the art. It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include, with Silverman et al's invention, a web browser in order to allow users of the invention to read HTML documents on the web.

[Claim 38] Official notice is taken that the use of multimedia equipment to capture information is old and well-known in the art. It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include, with Silverman et al's invention, multimedia equipment capable of capturing additional content for inclusion in the transaction terms in order to save the time of retyping terms that may already exist in some written, capturable format.

[Claims 1-19] Claims 1-19 recite an apparatus with limitations similar to those recited in claims 20-38; therefore, the same rejection is applied.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 2, 4-8, 21, and 23-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 and 11-16 of copending Application No. 09/192,729 in view of Silverman et al. (U.S. Patent No. 5,924,082) and further in view of Boesch et al. (U.S. Patent No. 5,897,621).

This is a provisional obviousness-type double patenting rejection.

[Incorporation of Boesch Reference]

Since transactions are being conducted globally, it seems almost inherent that some sort of internationally accepted payment method must be negotiated; however, Silverman et al do not

provide the specific payment details. Boesch et al disclose a system and method for multicurrency transactions. A customer and a merchant agree upon an accepted price in an accepted currency to be paid for a particular product (Boesch: Abstract). "Using well known techniques, the customer user **203** and a merchant user **303** agree on a product to be purchased at a price and in a currency" (Boesch: col. 7, lines 4-6). Silverman et al teach a well-known technique of negotiating, incorporating a "free-style dialog" for example (Silverman: col. 12, line 51). Since a dialog implies a conversation between at least two parties and certain terms may be renegotiated (Silverman: col. 13, lines 9-11), an artisan of ordinary skill in the art at the time of Applicants' invention would have reasonably interpreted such negotiations to be iteratively performed. While Silverman et al's invention is likely suited to accept major credit cards, which are a type of international accepted payments, Boesch et al more explicitly teach a method of approving an exchange of currency for international payment purposes. It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to incorporate Boesch et al's "system and method for determining approval of a multi-currency transaction between a customer and a merchant over a network" (Boesch: Abstract, lines 1-3) with Silverman et al's negotiated matching system and method in order to facilitate the use of a larger range of payment methods when conducting online international transactions for the convenience of merchants and customers located in different countries.

The following tables will address claim 2 of the present application versus claim 1 of copending Application No. 09/192,729 in detail. All other claim relationships will be summarized thereafter.

CLAIM 2

Application No. 09/192,729	=	Application No. 09/192,735
multivariate negotiations engine system	=	multivariate negotiations engine system
destination terminal	=	destination terminal
initiating terminal	=	initiating terminal
iterative negotiations + Silverman et al (col. 12, lines 25-30)	=	iterative negotiations + deciding entity
internationally accepted payment methods	=	generic payment methods + Boesch reference discussed above
international network	=	generic network + Rejection of claim 20 above

CLAIMS 4-8, 21 & 23-27

Application No. 09/192,729	=	Application No. 09/192,735
2	=	4
3 + Official notice that predefined templates are old and well-known.	=	5 + predefined templates
4	=	7
5	=	6
6	=	8

11	=	21 (see double patenting rejection of claim 2 above)
12	=	23
13 + Official notice that predefined templates are old and well-known.	=	24 + predefined templates
14	=	26
15	=	25
16	=	27

9. Claims 6 and 25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 of copending Application No. 09/192,848 in view of Silverman et al. (U.S. Patent No. 5,924,082).

This is a provisional obviousness-type double patenting rejection.

The following tables will address claim 6 of the present application versus claim 1 of copending Application No. 09/192,848 in detail. All other claim relationships will be summarized thereafter.

CLAIM 6

Application No. 09/192,735	**=**	**Application No. 09/192,848**
multivariate negotiations engine system	=	multivariate negotiations engine system
destination terminal	=	seller or buyer terminal

initiating terminal	=	buyer or seller terminal

CLAIM 25

SMD

Application No. 09/192,~~729~~ 735	=	**Application No. 09/192,848**
25 (see double patenting rejection of claim 6 above)	=	3

10. Claims 2 and 21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of copending Application No. 09/192,979 in view of Silverman et al. (U.S. Patent No. 5,924,082).

This is a provisional obviousness-type double patenting rejection.

The following tables will address claim 2 of the present application versus claim 1 of copending Application No. 09/192,979 in detail. All other claim relationships will be summarized thereafter.

CLAIM 2

Application No. 09/192,735	=	**Application No. 09/192,979**
multivariate negotiations engine system	=	multivariate negotiations engine system
destination terminal	=	destination terminal
initiating terminal	=	initiating terminal

no cryptography + Official notice that cryptographic techniques are old and well-known for security purposes.	=	secure transactions
network	=	network

CLAIM 21

Application No. 09/192,735	=	**Application No. 09/192,979**
21 (see double patenting rejection of claim 2 above)	=	6

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna Meinecke-Díaz whose telephone number is (703) 305-1337. The examiner can normally be reached Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached at (703) 305-9708.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

SMD
January 24, 2000

ALLEN R. MACDONALD
SUPERVISORY PATENT EXAMINER